

### **REMARKS**

Applicants have carefully reviewed the Office Action of April 29, 2009, in which claims 1-64 are pending and have been rejected. Claims 16, 20, 23, 26, 29, 31, 46, and 49 are amended to correct clerical/typographical errors. No new matter is added. Applicants request reconsideration in light of the above amendments and following remarks.

#### ***Claim Rejections***

Claims 1-3, 9, 12, 24-25, 27, 32-34 and 38 were rejected under 35 USC 102(b) as being anticipated by Gillies, USPN 6,272,370.

As noted in the December 20, 2007 Response, "The Gillies patent discloses an MR visible and/or X-ray visible drug delivery device that includes a linearly arranged array of radio-paque marker and MR-visible distal markers that are identifiable in an MR image and by X-rays (see FIGS. 1-2; col. 25, lines 39-53). Although the Gillies et al. patent discloses markers 6, it fails to disclose the use of fluoroscopic imaging enhancement material and MRI enhancement material in "separate concentric layers" which are "non-circumferentially contiguous" as recited by pending claims 1, 54. Claims 2 and 3 are dependent upon claim 1 and should be allowable for the same reasons. Applicants request withdrawal of the rejection." The rejection was withdrawn in the next Office Action.

For the above reasons, applicants again request withdrawal of the rejection with respect to independent claim 1 and dependent claims 2-3, 9, 12, 24-25, 27, 32-34 and 38, which depend from claim 1 and contain additional elements.

Claims 39-44, 46-47, 54, 56, 59 and 61 were rejected under 35 USC 102(b) as being unpatentable over Stinson, US 2005/0131522. Applicants respectfully traverse the rejection. Stinson pertains to a methods of making medical devices. However, applicants can find no teaching in Stinson of "a fluoroscopic imaging enhancement material and an MRI enhancement material; wherein the fluoscopying imaging enhancement material is provided in a first layer and the MRI enhancement material is provided in a second layer." Applicants can find no teaching in Stinson of an embodiment that includes a fluoroscopic imaging enhancement material and an MRI enhancement material in separate layers that are concentric

and bonded as claimed, in as much detail as claimed. As discussed below, Stinson is not available as prior art under 35 USC 103 and consequently it is not appropriate to treat this rejection as a 102/103 rejection. Because Stinson does not disclose the invention in as much detail as claimed, applicants respectfully request withdrawal of this rejection.

Claims 4-6 and 35 were rejected under 35 USC 103(a) as being unpatentable over Gillies in view of Bavaro, US 2005/0255317. Applicants respectfully traverse the rejection.

For at least the reason that these claims depend from claim 1, which applicants submit is allowable, and contain additional elements, applicants submit that these claims are in condition for allowance as well.

Claims 7-8, 10-11 and 13-16 were rejected under 35 USC 103(a) as being unpatentable over Gillies in view of Aita, USPN 6,884,234. Applicants respectfully traverse the rejection.

For at least the reason that these claims depend from claim 1, which applicants submit is allowable, and contain additional elements, applicants submit that these claims are in condition for allowance as well.

Claims 17-18 and 21-22 were rejected under 35 USC 103(a) as being unpatentable over Gillies in view of Dor, USPN 6,334,871. Applicants respectfully traverse the rejection.

For at least the reason that these claims depend from claim 1, which applicants submit is allowable, and contain additional elements, applicants submit that these claims are in condition for allowance as well.

Claims 19 and 21-22 were rejected under 35 USC 103(a) as being unpatentable over Gillies in view of Dor as applied to claim 17 above and further in view of MacDonald, US 2007/0093142. Applicants respectfully traverse the rejection.

For at least the reason that these claims depend from claim 1, which applicants submit is allowable, and contain additional elements, applicants submit that these claims are in condition for allowance as well.

Claim 20 was rejected under 35 USC 103(a) as being unpatentable over Gillies in view of MacDonald. Applicants respectfully traverse the rejection.

For at least the reason that these claims depend from claim 1, which applicants submit is allowable, and contain additional elements, applicants submit that these claims are in condition for allowance as well.

Claims 23, 28-31 and 36-37 were rejected under 35 USC 103(a) as being unpatentable over Gillies in view of Stinson. Claim 45 was rejected under 35 USC 103(a) as being unpatentable over Stinson in view of Kucharczyk, USPN 6,026,316. Claims 45-51 and 53 were rejected under 35 USC 103(a) as being unpatentable over Stinson in view of MacDonald. Claim 52 was rejected under 35 USC 103(a) as being unpatentable over Stinson in view of MacDonald as applied to claim 48 and further in view of Devens, US 2005/0124976. Claims 55 was rejected under 35 USC 103(a) as being unpatentable over Stinson in view of Zhong, US 2004/0186377. Claims 57-58 were rejected under 35 USC 103(a) as being unpatentable over Stinson in view of Bavaro. Claim 60 is rejected under 35 USC 103(a) as being unpatentable over Stinson in view of Dor. Claims 63-64 were rejected under 35 USC 103(a) as being unpatentable over Stinson in view of Ishii. Applicants respectfully traverse these rejections.

Stinson is not available as prior art under 35 USC 103. As can be seen in the patent assignment database, the present inventors assigned their interest Scimed Life Systems, Inc. at reel 014716, frame 0109, which name was subsequently changed to Boston Scientific Scimed, Inc. at reel 018505, frame 0868. Likewise, the inventors of the Stinson application assigned their interest to Scimed Life Systems, Inc. at reel 014798, frame 0182, which name was subsequently changed to Boston Scientific Scimed, Inc. at reel 018505, frame 0868. The obviousness rejections therefore cannot be properly maintained and applicants therefore submit that these claims are in condition for allowance.

Claim 62 is rejected under 35 USC 103(a) as being unpatentable over Gillies in view of Ishii, US 2003/0163117. Applicants respectfully traverse the rejection.

For at least the reason that these claims depend from claim 1, which applicants submit is allowable, and contain additional elements, applicants submit that these claims are in condition for allowance as well.

***Conclusion***

Reexamination and reconsideration are respectfully requested. It is respectfully submitted that the claims are now in condition for allowance, issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

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By their Attorney,

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